

REMARKS

In the Office Action¹ mailed on July 14, 2010, the Examiner took the following actions: rejected claims 109-115 under 35 U.S.C § 101; rejected claims 2, 5, 6, 8-12, 14, 18-20, 38, 41, 42, 60-62, 65-68, 72, 73, 77, 81-83, 86, 108-112, 114, and 115 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,425,012 to Trovato et al. ("*Trovato*") in view of U.S. Patent No. 7,035,926 to Cohen et al. ("*Cohen*"); rejected claims 99, 100, and 102-107 under 35 U.S.C. § 103(a) as unpatentable over *Trovato* in view of *Cohen* and further in view of U.S. Patent No. 7,401,098 to Baker ("*Baker*"); rejected claims 2, 5-21, 38-44, 60-63, 65-69, 71-77, 81-83, 87, 88, 99, 100, 102-112, 114, and 115 under 35 U.S.C. § 103(a) as unpatentable over *Baker* in view of *Cohen*; rejected claim 3 under 35 U.S.C. § 103(a) as unpatentable over *Trovato* in view of *Cohen* and U.S. Patent No. 6,459,673 to Smith et al. ("*Smith*"); rejected claims 101 and 113 under 35 U.S.C. § 103(a) as unpatentable over *Trovato* in view of *Cohen*, *Baker*, and *Smith*; rejected claims 3, 101, 113 under 35 U.S.C. § 103(a) as unpatentable in view of *Baker* and further in view of *Cohen* and *Smith*; rejected claims 78-80 under 35 U.S.C. § 103(a) as unpatentable over *Trovato* in view of *Cohen* and U.S. Patent Publication No. 2002/0059526 to Dillon et al. ("*Dillon*"); and rejected claims 78-80 under 35 U.S.C. § 103(a) as unpatentable over *Baker* in view of *Cohen* and *Dillon*.

By this amendment, Applicants amend claims 60, 77, 81, 99, 108, and 109. The originally-filed specification, claims, abstract, and drawings fully support the amendments to the pending claims. No prohibited new matter has been added. Claims

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

2, 3, 5-21, 38-44, 60-63, 65-69, 71-83, 86,88, and 99-115 remain pending and under examination. Applicants traverse the rejections and submit that the amended claims are allowable over the prior art of record for at least the following reasons.

I. Rejections under 35 U.S.C. § 101

The Office Action rejects claims 109-115 under 35 U.S.C 101 as directed to non-statutory subject matter. In particular, the Office Action rejects these claims for not being “positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter.” Office Action, p. 2.

Although the pending claims are clearly directed to statutory subject matter in view of the Supreme Court's recent guidance in *Bilski*, to advance prosecution Applicants have amended independent claim 109 to recite *inter alia* “[a] computer-implemented method for sharing one or more matching online traits between a user and a buddy of the user in an instant messaging communications system” with certain steps that are performed “using a processor.”

Based on the foregoing amendments, Applicants respectfully request that the rejections of claims 109-115 under 35 U.S.C. § 101 be withdrawn.

II. Rejections under 35 U.S.C. § 103

The Office Action rejects claims 2, 5, 6, 8-12, 14, 18-20, 38, 41, 42, 60-62, 65-68, 72, 73, 77, 81-83, 86, 108-112, 114, and 115 under 35 U.S.C. § 103(a) as unpatentable over *Trovato* in view of *Cohen*. The Office Action further rejects claims 99, 100, and 102-107, under 35 U.S.C. § 103(a) as unpatentable over *Trovato* in view of *Cohen* and further in view of *Baker*. The Office Action also rejects claims 2, 5-21, 38-44, 60-63, 65-

69, 71-77, 81-83, 87, 88, 99, 100, 102-112, 114, and 115, under 35 U.S.C. § 103(a) as unpatentable over *Baker* in view of *Cohen*. And, the Office Action rejects claims 3, 78-80, 101, and 113 under 35 U.S.C. § 103(a) as unpatentable over one or more of *Trovato*, *Baker*, *Cohen*, *Smith*, and *Dillon*. For at least the following reasons, these rejections should be withdrawn and the claims should be allowed.

Independent Claims 60, 77, 81, 99, 108, and 109

Amended Independent claim 60 calls for a combination including, for example “storing trait information for the other users when the other users enter the online context of the user and removing the stored trait information for the other users when the other users leave the online context of the user,” and “causing presentation, to the user, of an indicator before the user is in communication with any member of the identified group, the indicator identifying at least one user as a member of the group of the other users sharing the online context of the user and the at least one trait with the user”. (Emphases added.) *Trovato* fails to teach or suggest at least these features recited in amended claim 60.

Trovato purports to teach a chat server that “stores the user profile for some or all of the users.” *Trovato*, col. 3, ll. 51-53. *Trovato*, however, fails to teach or suggest “storing trait information for the other users when the other users enter the online context of the user,” and “removing the stored trait information for the other users when the other users leave the online context of the user,” as recited in amended claim 60 (emphases added). The Office Action alleges that *Trovato* teaches “causing presentation, to the user, of an indicator” via a “user interface” that “displays [a] chat room group.” Office Action, p. 3. However, this is incorrect. Even assuming *Trovato*

displays some form of indicators with respect to a chat room group, which Applicants do not concede, *Trovato* fails to teach or suggest "causing presentation, to the user, of an indicator before the user is in communication with any member of the identified group, the indicator identifying at least one user as a member of the group of the other users sharing the online context of the user and the at least one trait with the user," as recited in claim 60 (emphases added).

The Office Action cites *Baker* as teaching "storing trait information for the other users." Office Action, p. 8. *Baker* purports to teach "a database to provide or display a list of characteristics of one chatter to another chatter." *Baker*, col. 3, ll. 63-65. *Baker* also purports to teach "showing (or paging) a user with characteristics of another person who may be in the same chat system, but in another room. *Baker*, col. 4, ll. 41-43. *Baker*, however, fails to teach or suggest "storing trait information for the other users when the other users enter the online context of the user," and "removing the stored trait information for the other users when the other users leave the online context of the user." Moreover, *Baker* fails to teach or suggest "causing presentation, to the user, of an indicator before the user is in communication with any member of the identified group, the indicator identifying at least one user as a member of the group of the other users sharing the online context of the user and the at least one trait with the user," as recited in claim 60 (emphases added).

The Office Action acknowledges that neither *Trovato* nor *Baker* teach the online context being "one or more of a web site currently accessed by the user, an Internet domain currently accessed by the user, a newsgroup currently accessed by the user, or a URL currently accessed by the user." Office Action, pp. 4, 10. However, the Office

Action cites *Cohen* as allegedly teaching of “determining an online context being a website currently accessed (col. 1, lines 25-30-people awareness, other users currently online, document awareness-viewing same online place; col. 1, lines 35-40-keep track of users at particular webpage.” Office Action, pp. 6, 10. Even assuming the Office Action’s characterization of *Cohen* is correct, which Applicants do not concede, *Cohen* fails to cure the deficiencies of *Trovato* or *Baker* with respect to Applicants’ claims. That is, *Cohen* also fails to teach or suggest “storing trait information for the other users when the other users enter the online context of the user and removing the stored trait information for the other users when the other users leave the online context of the user,” and “causing presentation, to the user, of an indicator before the user is in communication with any member of the identified group, the indicator identifying at least one user as a member of the group of the other users sharing the online context of the user and the at least one trait with the user” as recited in independent claim 60 (emphases added).

Thus, *Trovato*, *Cohen*, and *Baker* individually or in combination fail to teach or suggest all of the features of claim 60. For at least these reasons, no *prima facie* case of obviousness has been established for independent claim 60 and the claim should be allowed.

Independent claims 77, 81, 99, 108, and 109 although of a different scope from claim 60 and each other include features similar to those presented above for claim 60. Accordingly a *prima facie* case of obviousness has not been established for claims 77, 81, 99, 108, and 109 for at least reasons similar to those given above and these claims should be allowed.

Dependent Claims

The Office Action relied on *Smith* as a teaching of “monitoring a currently accessed news group.” Office Action, p. 11. The Office Action also relied on *Dillon* as a teaching of “conditions for the users store.” *Id.* at 13. Even assuming the Office Action’s characterization of *Smith* and *Dillon* is correct, which Applicants do not concede, *Smith* and *Dillon* fail to cure the above-mentioned deficiencies of *Trovato*, *Baker*, and *Cohen* with respect to independent claims 60, 77, 81, 99, 108 and 109.

The pending dependent claims depend from one of independent claims 60, 77, 81, 99, and 109, and are, thus, allowable at least for the reasons set forth above with regard to their respective allowable base claims and further in view of the features recited by these claims.

CONCLUSION

In view of the foregoing , Applicants submit that the pending claims are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants, therefore, request the Examiner’s reconsideration and withdrawal of all rejections, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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